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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/087,132	07/02/1993	RICHARD GREGORY	IGI012CN	9512

7590 06/01/2005

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EXAMINER

CARLSON, KAREN C

ART UNIT	PAPER NUMBER
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1653

DATE MAILED: 06/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/087,132

Applicant(s)

GREGORY ET AL.

Examiner

Karen Cochran Carlson, Ph.D.

Art Unit

1653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 226-235 and 238-242 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 226-235, 238 and 239 is/are allowed.
- 6) ☒ Claim(s) 240-242 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 1653

This Office Action is in response to the after-final paper filed November 8, 2004. This paper has been entered. Claims 226-235, 238-239, and new claims 240-242 are currently pending and are under examination.

Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

The Declaration filed August 2, 2004 is acknowledged. The only remaining inventor is Richard Gregory.

Withdrawal of Rejections:

The provisional rejection of Claims 226-235, 238, and 239 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 19-21 of copending Application No. 08/311,665 is withdrawn because '665 has been abandoned.

The rejection of Claims 228-231 under 35 U.S.C. 112, second paragraph, is withdrawn.

New Rejections

The disclosure is objected to because of the following informalities:

The status identifiers of the claims are listed incorrectly. There are 7 options: original, currently amended, canceled, withdrawn, previously presented, new, and not entered. The use of a status identifier as "previously submitted" is not an option.

Appropriate correction is required.

New Claims 240-242 drawn to DNA encoding CFTR are the same as Claims 19-21 of 08/311,665, which were added in '665 after decision on interference in which Applicants lost similar claims drawn to DNA encoding CFTR to the count.

Art Unit: 1653

Claims 13-18 drawn to a vector were held allowable in '665 and were subject to obviousness-type double patenting with instant Claims 226-235, 238-239. Claims 13-18 were canceled, and the DNA claims 19-21 were added in '665. There was no restriction between DNA and vectors comprising DNA in '665, and therefore the double patenting rejection in '665 was maintained.

In the interview held November 4, 2004, the Examiner agreed that Applicants could move the claims from '665 into the instant application. Thus, the following rejection is being made:

Claims 240-242 are rejected on the ground of judicial doctrine and/or interference estoppel over the count of Interference No. 103,882. See *Ex parte Tytgat et al.*, 225 USPQ 907.

The rejection of Claims 240-242 is based upon the count of Interference No. 103,882, to which applicant was a party, is a rejection for the purpose of resolving all remaining issues in this application. The Count in Interference No. 103,882 was:

Nucleic acid encoding cystic fibrosis transmembrane conductance regulator (CFTR).

Applicants' application SN 08/311,665, Claims 10-12, lost this count in interference. The instant claims read on the count because the claimed DNA sequence the encodes CFTR, noting that the limitations to "capable of stable prokaryotic propagation...." still defines a DNA that encodes CFTR. Further, it has been held that the recitation of an element that is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchinson* 69 USPQ 138.

Claims 226-235 and 238-239 are allowable.

Art Unit: 1653

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karen Cochrane Carlson, Ph.D. whose telephone number is 571-272-0946. The examiner can normally be reached on 7:00 AM - 4:00 PM, off alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Jon Weber can be reached on 571-272-0925. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, reading "Karen Cochrane Carlson" followed by a stylized monogram or initials.

KAREN COCHRANE CARLSON, PH.D
PRIMARY EXAMINER